

REMARKS

By this paper, the Applicant has canceled Claims 19 and 20.

I. Discussion of Objections to the Drawings

In paragraph 1 of the Office action, the Examiner objected to drawings because elements 11-16 of Figures 1a-f; elements 21, 23, 25-90, 250, 251, 254 of Figures 2a-e are not mentioned in the written description in violation of 37 C.F.R. § 1.84(p)(5). As indicated above, the Applicant has amended Figures 1a-f and 2a-e to remove reference signs that are not mentioned in the specification. In paragraph 2 of the Office action, the Examiner objected to the drawings because they do not include reference sign 37 (contact area), which is mentioned in the specification. The Applicant has corrected Figures 3c and 8b to clearly show the contact area 37. Finally, the Examiner objected to the drawings, because the drawings do not allegedly show certain features recited in Claims 19 and 20. Since the Applicant has cancelled Claims 19 and 20, the Applicant submits that the objection to the drawings is now moot.

II. Discussion of Objections to the Specification

In paragraph 4 of the Office action, the Examiner objected to the title of the invention for not being descriptive. As noted above, the Applicant has amended the title to more clearly indicate the invention to which the claims are directed. Additionally in paragraph 5 of the Office action, the Examiner objected to the specification for the presence of improper designation of figures and typographical errors. As noted above, the Applicant has amended the specification and, hence, the objection to the specification is now overcome.

III. Discussion of Objections to the Claims

In paragraph 6 of the Office action, the Examiner objected to the Claims because of the recitation of "mould" (instead of "mold"), and of the need for clarifying the structural relation between the contact area and probe tip (Claim 6), and between the cantilever and probe (Claim 8). The Applicant submits that the amendment to the claims above clarifies such informalities and, hence, overcomes said claim objections.

IV. Discussion of Rejection of Claims 4, 5, 19 and 20 Under 35 U.S.C. § 112

In paragraph 8 of the Office action, the Examiner rejected Claims 19 and 20 as failing to comply with the enablement requirement of § 112, first paragraph. While the Applicant disagrees with the Examiner's determination, the Applicant has canceled Claims 19 and 20, without prejudice, in the interest of expediting prosecution. Thus, this and other rejections of Claims 19 and 20 are now moot in view of the cancellation of those claims.

In paragraph 9 of the Office action, the Examiner rejected Claims 4, 5, 19 and 20 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. More particularly, the Examiner noted that each of Claims 4 and 5 depends on itself, respectively. As noted above, the Applicant has amended Claims 4 and 5, so that Claim 4 depends on Claim 3, and Claim 5 depends on Claim 4. Also, the Applicant has corrected any other indefinite terminology where necessary. Thus, the Applicant submits that the rejection to Claims 4 and 5 is now overcome.

V. Discussion of Rejection of Claims 17 and 18 Under 35 U.S.C. § 102(b)

In paragraph 12 of the Office Action the Examiner rejected Claims 17 and 18 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,923,033 to Takayama et al. ("Takayama"). In rejecting Claims 17 and 18, the Examiner stated that "since the claims is drawn to a product-by-process, the claimed invention can be anticipated by the prior art by simply showing the product." *O.A. at page 5.*

Anticipation under Section 102 can be found only if a reference shows exactly what is claimed. *Titanium Metals Corp. v. Banner*, 778 F.2d 775 (Fed. Cir. 1985). More particularly, a finding of anticipation requires the disclosure in a single piece of prior art of each and every limitation of a claimed invention. *Electro Med. Sys. S.A. v. Cooper Life Sciences*, 34 F.3d 1048, 1052 (Fed. Cir. 1994). "To anticipate, every element and limitation of the claimed invention must be found in a single prior art reference, arranged as in the claim." *Brown v. 3M*, 265 F.3d 1349 (Fed. Cir. 2001). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970).

The Applicant submits that Takayama fails to teach all of the limitations of Claims 17 and 18, as amended. The Applicant has amended Claims 17 and 18 to recite conventional

Appl. No. 09/955,565

Amdt. Dated August 20, 2003

Reply to Office action of May 21, 2003

apparatus type claims by reciting specific structural elements for the claimed probe. The Applicant submits that Claims 17 and 18 are patentable over the cited art of record, and respectfully requests that the rejection of Claims 17 and 18 be withdrawn.

VI. Conclusion

Applicant has endeavored to address all of the Examiner's concerns as expressed in the Office Action. Accordingly, amendments to the claims, the reasons therefor, and arguments in support of patentability of the pending claim set are presented above. Any claim amendments which are not specifically discussed in the above remarks are made in order to improve the clarity of claim language, to correct grammatical mistakes or ambiguities, and to otherwise improve the clarity of the claims to particularly and distinctly point out the invention to those of skill in the art. Finally, Applicant submits that the claim limitations above represent only illustrative distinctions. Hence, there may be other patentable features that distinguish the claimed invention from the prior art.

In view of the foregoing, Applicant respectfully requests reconsideration and withdrawal of the outstanding rejections and, particularly, that all claims be allowed. If the Examiner finds any remaining impediment to the prompt allowance of these claims that could be clarified with a telephone conference, the Examiner is respectfully invited to call the undersigned.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: August 20, 2003

By: 

Mark M. Abumeri

Registration No. 43,458

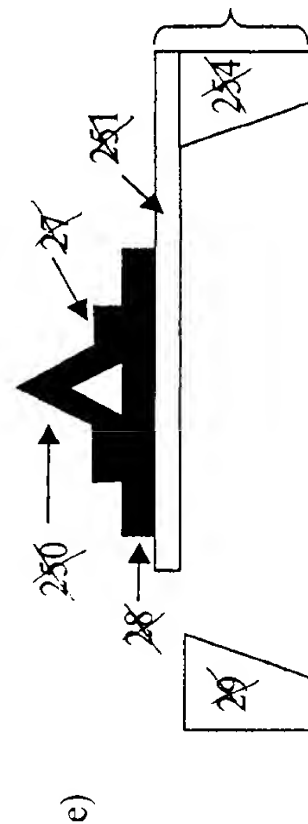
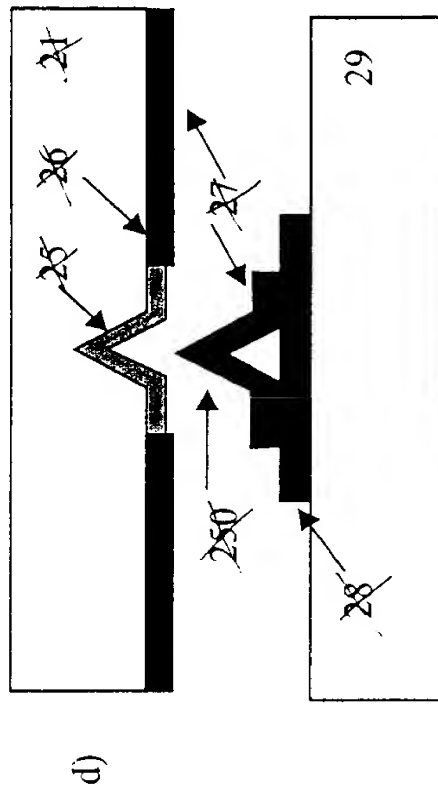
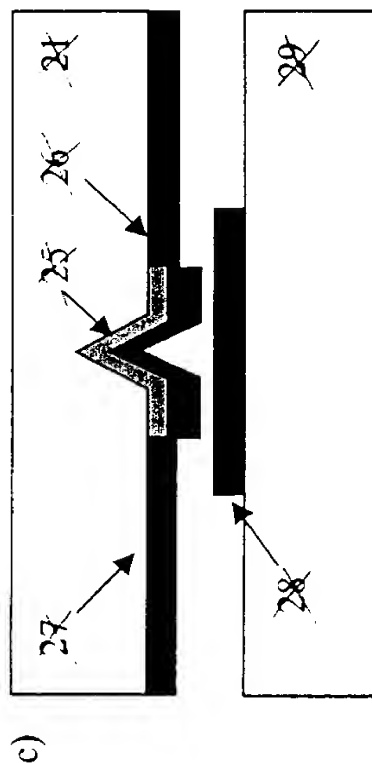
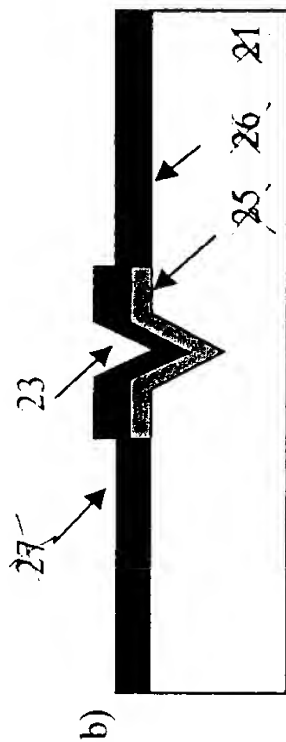
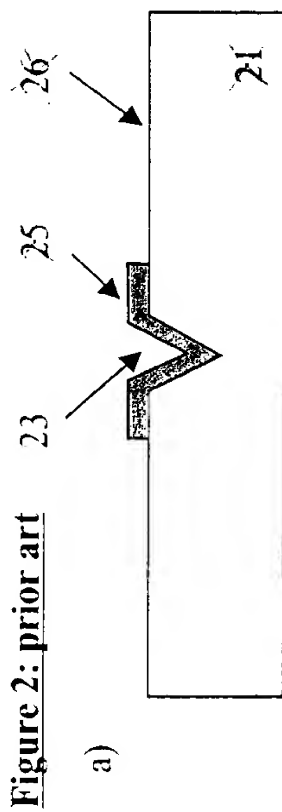
Attorney of Record

Customer No. 20,995

(619) 235-8550



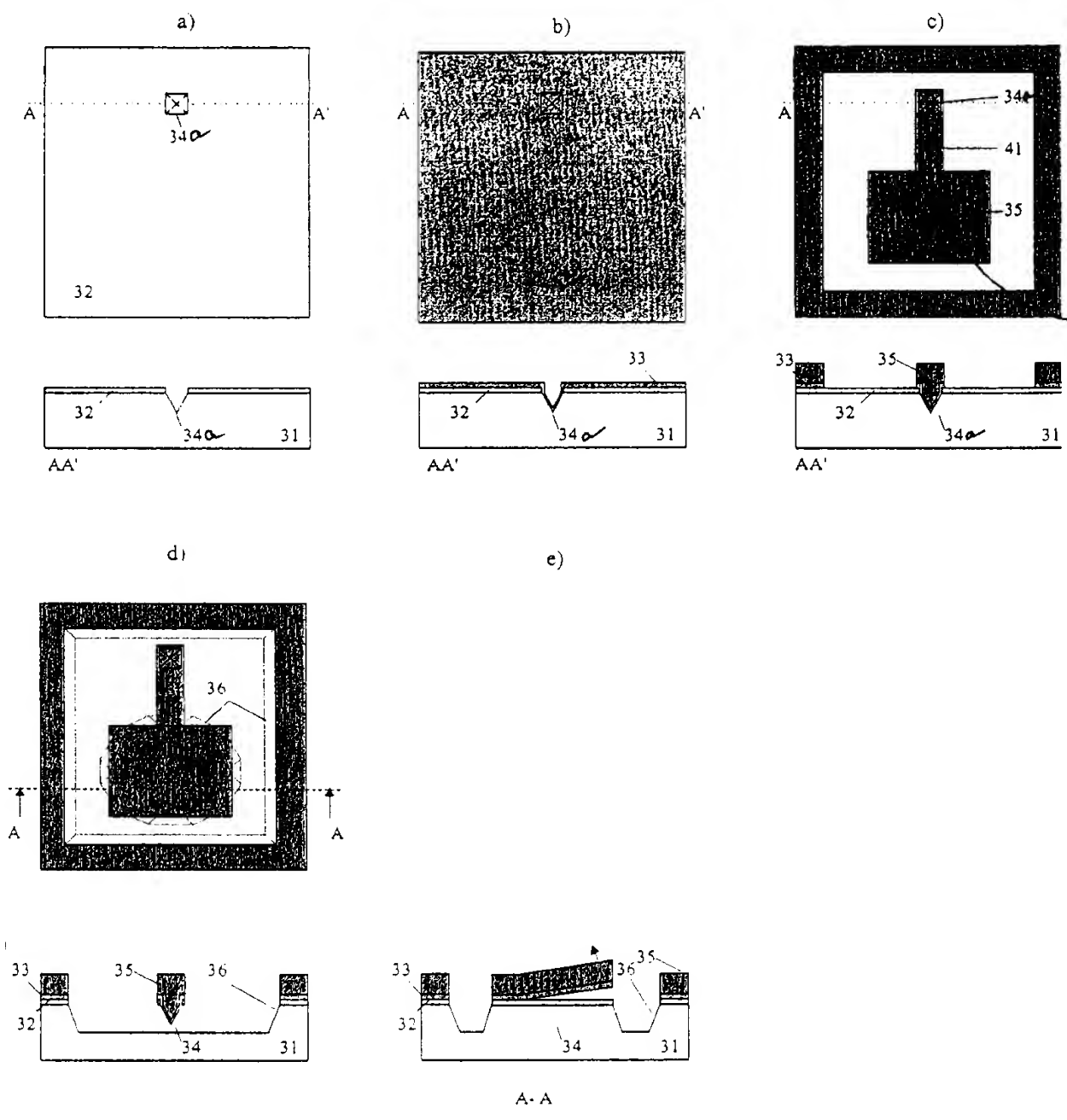
Some numbers removed





Appl. No.: 09/955,565
Amdt. Dated: August 20, 2003
Reply to Office Action of May 21, 2003
Atty Docket: IMEC222.001AUS
Annotated Sheet Showing Changes

Figure 3



Added
37

